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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,456	04/02/2004	Geoffrey B. Rhoads	P0965	1643
23735	7590	04/15/2005	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,456

Applicant(s)

RHOADS, GEOFFREY B.

Examiner

EDWYN LABAZE

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1102005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of IDS and amendments filed on 1/10/2005.
2. Claims 1-17 are presented for examination.
3. This application is a continuation of 10/717,211 filed on 11/18/2003, which is a continuation of application # 09/342,688 filed on 06/29/1999 (now U.S. 6,650,761), which is a CIP of application # 09/314,648 filed on 5/19/1999 (now U.S. 6,681,028) and claims the benefits of provisional application # 60/134,782 filed on 05/19/1999.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Kitano et al. (U.S. 5,926,116).

Re claims 1 and 15: Kitano et al. discloses information retrieval apparatus and method, which includes using a handheld appliance [herein described a portable terminal/telephone 1] (as shown in fig. # 1; col.3, lines 15+), receiving digital data [herein the image of the poster was obtained through a camera 24 incorporated within the portable terminal] from the poster 41 (as shown in fig. # 6); and by reference to the data received from the poster 41, establishing a link to a remote computer 21 (col.5, lines 18-67; col.6, lines 1-67).

Re claims 2 and 17: Kitano et al. teaches an apparatus and method, wherein the appliance 1 is a wireless device [portable telephone; as shown in fig. # 8] (col.2, lines 10+).

Re claim 3: Kitano et al. discloses an apparatus and method, wherein the appliance 1 comprises a computer 55 (as shown in fig. # 8; col.2, lines 12+).

Re claim 4: Kitano et al. teaches an apparatus and method, wherein the appliance 1 comprises a camera 24 (col.4, lines 54+; col.5, lines 4-24).

Re claims 5-6: Kitano et al. discloses an apparatus and method, wherein the appliance 1 includes an output device [herein described as a CRT 28 display/screen and a modem 27 with means of outputting the digital data/image, text, and or video of the scanned product], and the method includes presenting information to a user based on data obtained from the remote computer 21 using the output device, and wherein the output device includes a screen (see fig. # 4; col.6, lines 25-61).

Re claims 10-11: Kitano et al. teaches an apparatus and method, further includes communicating over the link to cause electronic content [such as images, or song/music and the like] to be downloaded to a user of the appliance 1 (col.6, lines 25+).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitano et al. (U.S. 5,926,116) in view of Ausems et al. (U.S. 6,434,403).

The teachings of Kitano et al. have been discussed above.

Kitano et al. fails to teach a portable device with a camera and an annunciator.

Ausems et al. teaches personal digital assistant 100 with wireless telephone, which includes a camera 190 and an annunciator/speaker 135/185 (col.5, lines 10+).

In view of Ausems et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a camera and an annunciator/speaker into the teachings of Kitano et al. so as to capture a picture/image and enable means of announcing input/output signals. Furthermore, the intended use of scanning an image/barcode from a package or advertisement is functionally equivalent as of taking a snapshot of the image using a camera coupled to the portable device, and wherein most scanners in the art include a camera/CCD. Moreover, such modification would have been an obvious extension as taught by Kitano et al., therefore an obvious extension.

8. Claims 8-9, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitano et al. (U.S. 5,926,116) in view of Tarbouriech (U.S. 6,674,993).

The teachings of Kitano et al. have been discussed above. Kitano et al. further discloses that the poster 41 displays an image of a restaurant {"Restaurant Taxim de Paris"} (col.5, lines 25).

Kitano et al. fails to teach a poster for promoting a ticketed event, such as a concert or movie.

Tabouriech discloses method and system for identifying data locations associated with real world observations, which includes poster for promoting ticketed event for concert or movie (col.12, lines 13-14).

In view of Tabouriech's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a poster into the teachings of Kitano et al. for promoting ticketed event for concert or movie. Furthermore, such modification would enable the user to download information [such location, direction, even menu and/or placing online reservation if available through the place website] of a place/restaurant by scanning [as taught Kitano et al.] or taking a snapshot of an image associated with the poster/advertisement, and linking [via a wireless transmission over the internet] the decoded digital data/image from the scanned barcode with a website associated with the image. Moreover, such modification would have been an obvious modification as taught by Kitano et al., therefore an obvious expedient.

9. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitano et al. (U.S. (U.S. 5,926,116) in view of Gabbard et al. (U.S. 6,205,432).

The teachings of Kitano et al. have been discussed above. Kitano et al. further discloses a wireless transmission {using radio wave technology} path (col.4, lines 13+; col.7, lines 18+).

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Kitano et al. fails to teach means of using electromagnetic communications, optical sensing, and printing that includes a plural-bit code steganographically encoded therein.

Gabbard et al. discloses background advertising system, which includes means of using electromagnetic communications, optical sensing (col.8, lines 25+), and printing that includes a plural-bit code steganographically [also known in the art as a digital watermark] encoded therein (col.4, lines 7+).

In view of Gabbard et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Kitano et al. means of using electromagnetic communications, optical sensing, and printing that includes a plural-bit code steganographically/watermark encoded therein into the teachings of Kitano et al. as a means of transmitting/receiving the code/image from the poster. Furthermore such modification would provide more ways of transferring data among the modules/ports, and means of embedded codes printed onto the poster/advertisement, which relates/directs to specific website or internet address for promotional considerations. Moreover, such modification would have been an obvious extension as taught by Kitano et al., therefore an obvious expedient.

Response to Arguments

10. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Narayanaswami et al. (U.S. 6,504,571) discloses system and methods for querying digital image archives using recorded parameters.

Hashimoto et al. (U.S. 6,507,371) teaches communication apparatus and method that link network address with designated image information.

Gotou et al. (U.S. 6,789,102) discloses system for retrieving information based on position of communication terminal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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el
Edwyn Labaze
Patent Examiner
Art Unit 2876
March 22, 2005

A handwritten signature in black ink, appearing to read 'Thien M. Le', with a stylized, flowing script.

THIEN M. LE
PRIMARY EXAMINER